

Appl. No. : **10/031,818**
Filed : **March 6, 2002**

REMARKS

Claims 1-30 have been cancelled and replaced with new claims 31-44. Claims 31-44 are now pending in this application. Support for the amendments is found in the existing claims and the specification as discussed below. Accordingly, the amendments do not constitute the addition of new matter. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Support for new claims

Support for new Claim 31 is found in former claim 5.

Claim 32 finds support in former claim 5 and includes the additional limitations that the homology is not less than 90% (as opposed to 85% in claim 5), that the size is not more than about 2 kb and includes terminal inverted repeat sequences in the 5' and 3' regions. Support is found in the specification. See page 20, lines 17-21; and page 21, lines 1-10.

Claim 33 finds support in former claim 11 and includes the additional limitations for the DNA of (b) that the homology is not less than 90% (as opposed to 85% in claim 11), that the size is not more than about 2 kb and includes terminal inverted repeat sequences in the 5' and 3' regions. Support is found in the specification. See page 20, line 17-21; and page 21, lines 1-10. The DNA of (d) in claim 33 includes the additional limitations that the nucleotide sequence is not less than 90% (as opposed to 85%) homologous and has a size of not more than 1 kb. Support is found in the present specification at page 24, lines 12-14 and page 25, line 12.

Claim 34 finds support in former claim 12.

Claim 35 finds support in former claim 21.

Claim 36 finds support in former claim 22.

Claim 37 finds support in former claim 23.

Claim 38 finds support in former claim 24.

Claim 39 finds support in former claim 25.

Claim 40 finds support in former claim 26.

Claim 41 finds support in former claim 27.

Claim 42 finds support in former claim 28.

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Claims 43 and 44 find support in Examples 3-5, Figures 12 and 13 and Tables 1-4 of the present specification.

The grounds of rejection are discussed below as they apply to the present claims.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 5, 8, 11, and 22-30 were rejected under 35 U.S.C. § 112, first paragraph as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) has possession of the claimed invention at the time that the application was filed.

This ground of rejection was not applied to claims 12 and 21 which correspond to present claims 34 and 35. In addition, claim 31 is limited to SEQ ID NO: 1. Accordingly, claims 31, 34, and 35 meet the written description requirement.

Regarding the remaining claims, while Applicants respectfully submit that the present claims meet the written description requirement, Applicants are presently conducting experiments to show that the written description in the specification evidences possession of the invention at the time of filing. Experiments are expected to be completed shortly.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 5, 8, 11-12 and 21-30 are rejected under 35 U.S.C. § 112, first paragraph because the specification, while being enabling for an isolated miniature inverted-repeat transposable element (MITE)-like element having the nucleotide sequence of SEQ ID NO: 1, a recombinant DNA element having the nucleotide sequence of SEQ ID NO: 3, and a recombinant DNA element having the nucleotide sequence of SEQ ID NO: 14, does not reasonably provide enablement for other isolated MITE-like elements, or isolated MITE-like elements that are capable of causing duplication of a target sequence, or other recombinant DNA elements, or recombinant DNA elements that activate transcription or that transpose.

Present claim 31 is limited to an isolated miniature inverted-repeat transposable element consisting of a DNA having the sequence of SEQ ID NO:1. Accordingly, claim 31 clearly falls within the subject matter indicated as enabled by the previous Office Action. Present claims 34 and 35 are limited to SEQ ID NOS: 3 and 14, respectively. While these claims recite “an isolated transcriptional activation element” in the preamble, this is merely a recitation of intended

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use. Accordingly, claims 31, 34, and 35 are believed to be meet the enablement requirement of 35 U.S.C. § 112, first paragraph.

In addition, claims 43 and 44 are believed to be enabled, at least with regards to SEQ ID NOS: 1, 3, and 14, as the Examiner indicated in the previous Office Action that "Applicants have provided guidance with respect to how to use the disclosed MITE-like sequences to increase transformation efficiency and improve regeneration efficiency in plant cells" (Office Action of 3/17/05, page 20-21, bridging sentence).

Regarding the remaining claims, while Applicants submit that all of the present claims are completely enabled, as noted above, Applicants are conducting experiments to further evidence that the specification as filed fully enables the present claims. These experiments are expected to be completed shortly.

CONCLUSION

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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